

REMARKS

Claims 21-34 are currently pending and stand rejected. Claims 1-20 are cancelled without prejudice. Claims 35-39 are withdrawn from consideration following a restriction requirement. Claim 40 is added. Reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

Claims 21-27 were rejected under 35 U.S.C. 101. Examiner has indicated that these claims are rejected for the same reason as indicated for claims 28-34. Claims 28-34 were rejected as method claims that "claim an abstract idea without claiming a physical transformation or a specific machine. *In re Bilski*, 88 USPQ2d 1384.

Assignee respectfully traverse the rejection to claims 21-27 because the foregoing claims are not directed to a method. Therefore, the holding of *Bilski* does not even apply to claims 21-27.

Nevertheless, Examiner notes "the discussion of apparatus claim 7 corresponding to method claim 5 in *In re Abele*." *Abele* applied two steps - (1) determining whether the claim recites an "algorithm" within the meaning of *Benson*; and (2) determining whether that algorithm is applied in any manner to physical elements or process steps." *Abele*, 684 F.2d at 905-07. The foregoing was known as the Freeman-Walter-Abele test. *Bilski* expressly overruled this test.

While it is true that *Bilski* referred to *Abele* while discussing the transformation part of the "machine-

transformation test", discussed below, *Bilski* cautioned "To the extent that some of the reasoning in these decisions relied on considerations or tests, such as 'useful, concrete, and tangible result' [another test that was overruled along with Freeman-Walter-Abele], that are no longer valid as explained above, *those aspects of the decisions should no longer be relied on. Thus we reexamine the facts of certain cases under the correct test* to glean greater guidance as to how to perform 101 analysis using the machine-or-transformation test." When *Bilski* reexamined the facts of *Abele* under the machine-transformation test, *Bilski* concurred with the outcome on process claims 5 and 6, but didn't even mention claim 7.

Moreover, even in *Abele*, the "apparatus claim 7" was a entirely a means plus function claim that was deemed "an attempt to exalt form over substance since the claim is really to the *method or series of functions itself*". The present case is materially distinguishable none of the claims use means plus function language.

Accordingly, Assignee respectfully traverses the rejection and requests that Examiner withdraw the rejection to claims 21-27.

Claim 28 is amended to recite, among other limitations "storing the data structure in a memory; and generating the pixels of the single color for the at least one of the graphics images by applying the single color to the corresponding one of the logical surfaces using the color specified in the data structure by a processor."

Assignee respectfully submits that claim 28 now recites, now claims a process tied to a specific machine.

It is noted that *Bilski* permits a claim to a process under 35 U.S.C. 101, if it is either tied to a machine or transforms articles or materials.

The quoted portion of *In re Bilski* was part of a discussion of the transformation part of the test. Thus, Assignee is not required to claim 'a visual depiction that represents specific physical objects or substances' from *Bilski*.

Examiner also contends that the graphics processor and memory are "insignificant post-solution activity". As an initial matter, Although *Bilski* discusses "insignificant post-solution activity", the Abele case is never cited in that context. Thus, Assignee traverses Examiner's assertion that "In view of *In re Bilski's* reference to *In re Abele* the nominal apparatus limitations, memory and graphics processor, of these systems do not limit the claimed method to a physical transformation or a specific machine, and are considered to be insignificant extra-solution activity." As noted above, *Bilski* only concurred with the outcome of the process claims on the issue in *Abele* on the issue of transformation, but overruled the reasoning.

Moreover, neither *Bilski* or *Abele* were even based on whether an apparatus limitation is "nominal" or not. None of the rejected claims (including "apparatus claim 7") recited any specific apparatus limitation that was not defined by its function.

Assignee respectfully submits that "generating the pixels of the single color for the at least one of the graphics images by applying the single color to the corresponding one of the logical surfaces using the color specified in the data structure by a processor" is anything but insignificant extra solution activity.

Finally Examiner has stated that "generically claimed graphics processor is considered not to be a specific machine". Assignee respectfully traverses the rejection, and notes that clearly, the processor is not an abstract idea, algorithm, action, or act. Assignee can see no other category that the processor can fall into besides machine or article. Thus for at least the foregoing reasons, Assignee respectfully requests that Examiner withdraw the rejection to claims 28-34.

For at least the foregoing reasons, Assignee respectfully submits that each of the pending claims are allowable and Examiner is respectfully requested to pass this case to issuance. The Commissioner is hereby authorized to charge additional fees or credit overpayments to the deposit account of McAndrews, Held & Malloy, Account No. 13-0017.

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Respectfully submitted,



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